

Remarks

Claims 1, 2, 3, 7, 14-16 and 20-22 are amended. Claims 1, 7, 14 and 22 are amended to recite the original transition phrase. Claims 2, 7, 15 and 20 are amended to express a minimum with alternative language. Claims 3, 10 and 16 are amended to more properly express a maximum. No issue of new matter arises.

Rejections under 35 USC §103

The February 7, 2008 Office Action contained two 35 USC §103 rejections. At page 5, claims 1-25 were rejected over Decker in view of Corominas and Armstrong. At page 7, claims 1-25 were rejected over Trevigen in view of Armstrong, Sundberg and Human Molecular Genetics. Applicants respectfully traverse these rejections.

Decker is applied as teaching a PARP assay using immobilized activated PARP, but that does not use a fluorescently labeled NAD. Corominas is applied as an attempt to partially remedy this deficiency, by using a radioactive label. Then Armstrong is applied for teaching use of 1,N⁶-etheno NAD as a fluorescently leveled NAD.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

This rejection fails to establish a *prima facie* the prior art references when combined fail to teach or suggest all the claim limitations. At least the part of element (a)(iii) "NAD⁺ having an ADP ribose group labeled with a fluorescence label" is not taught by these applied references. The Office Action has made no assertion that this limitation can be found in the references when combined. Hence, upon reconsideration, withdrawal of this rejection is deemed proper. Other limitations not cited in the reference teachings have not been discussed herein as further rationale for withdrawal would be surplusage unduly adding to the length of this reply. Reconsideration and withdrawal of this rejection are respectfully requested.

Trevigen is applied as teaching incubating PARP, an inhibitor, a substrate (biotinylated NAD⁺, DNA, histone), detecting enzymatic activity and comparing measurements. Armstrong is cited as above merely teaching a fluorescent label (1,N⁶-etheno

NAD). Sundberg is applied as providing motivation. Human Molecular Genetics is applied for teaching various fluorescent labels.

This rejection fails to establish a *prima facie* the prior art references when combined fail to teach or suggest all the claim limitations. At least the part of element (a)(iii) "NAD" having an ADP ribose group labeled with a fluorescence label" is not taught by these applied references. The Office Action has made no assertion that this limitation can be found in the references when combined. Hence, upon reconsideration, withdrawal of this rejection is deemed proper. Other limitations not cited in the reference teachings have not been discussed herein as further rationale for withdrawal would be surplusage unduly adding to the length of this reply. Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants respectfully submit that the application is now in condition for allowance and request prompt notice thereof. Should the Examiner believe that an interview would advance the prosecution of this application, Applicants respectfully request him to contact the undersigned at the number below.

Respectfully submitted,



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